

**REMARKS**Regarding the Status of the Claims:

Claims 1 – 13 are pending.

No claims have been withdrawn from consideration.

Regarding the Claim Amendments presented in this reply:

The amendments to the claims do not add new matter. Claim 6 has been rewritten in independent form, reciting all the features of independent claim 1, from which it previously depended.

Regarding the Claim Rejections:

Applicants respectfully submit that the rejection of claims 1 – 13 under 35 U.S.C §102(b) as anticipated by US 6,723,464 to Tabata et al. (hereinafter, “Tabata”) should be withdrawn.

First, applicants respectfully submit that contrary to the allegation on page 3 of the Office action Tabata does not disclose step C of claim 1, because it does not describe electrochemically depositing the ions of a catalytic component from a polymer-electrolyte membrane and/or from an ionomer, introduced into reaction layers, on an electron conductor onto at least one side of a polymer-electrolyte membrane. It is improper to suggest the inherency of missing descriptive matter in a reference based on “probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>1</sup> In order “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of

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<sup>1</sup> MPEP §2112, citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

ordinary skill.”<sup>2</sup>

More importantly, 35 U.S.C §102(b) precludes patentability, if “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” The present application was filed in the United States on December 10, 2003. US 6,723,464 was issued on April 20, 2004. Thus, US 6,723,464 is not prior art under 35 U.S.C §102(b).

This reply is being filed along with an Information Disclosure Statement that cites US 2002/0071980 A1 by Tabata et al. Applicants respectfully note that a new rejection over US 2002/0071980 A1 could not properly be made final, as it would not have been necessitated by the amendments presented herewith. Moreover, applicants respectfully note that it would be inappropriate to assume that the disclosure of US 2002/0071980 A1 by Tabata et al. is identical to the disclosure of US 6,723,464 to Tabata et al.

In Conclusion:

The present application is in condition for allowance. Applicants request favorable action in this matter. In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner is welcome to contact the undersigned by phone to further the discussion.

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<sup>2</sup> *Id.*